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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Citovsky et al.)
Serial No.: 09/435,274) Examiner: D. Lamberston
Filed: November 5, 1999) Art Unit: 1636
For: GENETIC ASSAY FOR PROTEIN)
NUCLEAR TRANSPORT)

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants request reconsideration of the
outstanding office in view of the following remarks.

Applicants acknowledge acceptance of the drawings.

The rejection of claims 1-33 and 35 under 35 U.S.C.
§ 102(a) as anticipated by WO98/49284 to Ueki et al. ("Ueki")
is respectfully traversed because the present invention was
reduced to practice prior to the effective date of Ueki.

As set out in the Declaration Under 37 CFR § 1.131
attached hereto ("Declaration"), Ueki was filed as
International Application PCT/JP98/01936 on April 27, 1998 and
published on November 5, 1998. (Declaration ¶ 3). Accordingly,
the available effective date of Ueki as a reference against
the above-identified patent application is November 5, 1998.
(Id.) The above-identified patent application was filed on
November 5, 1999, claiming priority to U.S. Provisional Patent
Application No. 60/107,417, filed on November 6, 1998.
(Declaration ¶ 4) The invention covered by the claims of the
above-identified patent application was reduced to practice
before November 5, 1998 (i.e. prior to the effective date of
Ueki). (Declaration ¶ 5). As evidence of the reduction to
practice, is a letter from the assignee of the above-
identified patent application (The Research Foundation of
State University of New York; recorded at Reel/Frame

010704/0024) forwarding a description of the invention to an attorney for review prior to filing with the U.S. Patent and Trademark Office. (Declaration ¶ 6). The date of this letter was prior to November 5, 1998. (Id.) The documentation covering the invention was submitted under cover of the letter dated prior to November 5, 1998. (Declaration ¶ 7). This disclosure was ultimately filed as U.S. Provisional Patent Application Serial No. 60/107,417 on November 6, 1998. (Id.) This disclosure related to a construct (chimeric nucleic acid) which expresses a fusion protein for use in an assay for nuclear transport and a host cell and vector which includes the chimeric nucleic acid encoding the fusion protein, and a modified LexA protein having no nuclear localization signal. (Declaration ¶ 8).

Accordingly, because the invention was reduced to practice prior to the effective date of Ueki, the rejection is traversed (Manual of Patent Examining Procedure 715.01).

Applicants believe that the present case is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

September 17, 2003

Date

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